

REMARKS

The withdrawal from consideration of the several claims as being directed to non-elected invention is believed erroneous and the reinstituting of these, Claims 10-14 in the instant application is urged.

In the course of prosecution the claims presented for examination were as follows:

Claims 1-8 drawn to a laminate

Claim 9 drawn to a method of using the laminate

Claims 10-14 drawn to a process for making a laminate

Claim 15 to the laminate made by the process.

The Applicants received an action on the invention embodied in Claims 1-9; these Claims have been cancelled in favor of (RCE) Claims 10-15.

In withdrawing Claims 10-14 as being directed to a non-elected invention the Examiner stated that:

"Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits." (emphasis added).

As neither the embodiments of Claims 1-14 nor that of Claim 15 "received an action on the merits" the Examiner is in error in withdrawing these claims from consideration.

As noted below, Applicants respectfully assert that Examiner's action is unwarranted and legally unsupported.

Reconsideration of the restriction and reinstituting of the claims at issue are requested.

Claim 15 is directed to a laminate prepared by process that entails (i) applying a printed layer that contains a high temperature-resistant colored ink to a transparent thermoplastic polyurethane layer having a softening temperature (according to Kofler) of 140 to 180°C, a Shore A hardness of 50 to 95, and a thickness of at least 0.025 mm to produce a printed film and (ii) placing the printed film in a mold of an injection molding machine equipped with a nozzle, the printed layer facing the nozzle and (iii) injecting into the mold a thermoplastic material to form a substrate, the process being characterized in that the printed film is not preformed.

Claim 15 stands rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,733,651 (Wank).

Wank disclosed a laminate that included a colored layer and entails several different thermoplastic films. The referenced laminate is characterized in that, among others (i) “the printed decoration is protected from smearing and abrasion because it lies between the cover film and the support layer” – see column 11 lines 65 et seq., and (ii) prior to placing the decorated film in the open injection mold” the film is shaped- see column 12 line 24.

The presently claimed laminate is prepared by a process in which the printed layer is positioned in the mold “facing the nozzle” and in which the film is not preformed.

That is to say that the claimed laminate differs from Wank in that it contains no “cover film” and in that it is not shaped. Clearly, the patentability of the claimed laminate is predicated on its structure and configuration and not on the method used for its preparation.


In view of the above it is clear that the claimed invention is not described by Wank and that the rejection under section 102 is untenable.

Applicants respectfully submit that Claims 1-14 and Claim 15 rightfully belong in the same single application. Attention is called to MPEP 806.05(f) for the proper criteria for restriction between Process of Making and Product Made.

Reconsideration of the application and the introduction of Claim 10-14 in view of the above are requested.

Believing the above is a complete response to the outstanding Office Action and that the application is in condition for allowance the Applicants request an early indication to this effect.

Respectfully submitted,

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